

REMARKS

Claims 1-15 are pending in the application.

Claims 1-15 have been rejected.

Claim 1 was amended. Entry of this amendment is respectfully requested, as it simplifies issues for appeal.

Reconsideration of the claims is respectfully requested.

I. CLAIM REJECTION 35 U.S.C. §101:

Claims 1-5 were rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter.

Claims 1 is amended above in accordance with the Examiner's suggestions, and these rejections are believed obviated. Entry of this amendment is respectfully requested, as it is believed to remove this rejection from appeal. If the Examiner is not satisfied with this amendment, she is cordially and respectfully requested to telephone the undersigned to resolve the issue.

Accordingly, the Applicants respectfully request the Examiner to withdraw the statutory subject matter rejection.

II. CLAIM REJECTION UNDER 35 U.S.C. § 103

Claims 1-15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application No. 2003/0055697 to *Macken, JR. et al.*, hereinafter "Macken". The Applicants respectfully traverse the rejection.

In rejecting claims under 35 U.S.C. § 103(a), the examiner bears the initial burden of establishing a *prima facie* case of obviousness. (*In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). See also *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984)). It is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. (*Id.* at 1073, 5 USPQ2d at 1598). In so doing, the examiner is expected to make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), viz., (1) the scope and content of the prior art; (2) the differences between the prior art and the claims at issue; and (3) the level of ordinary skill in the art. In addition to these factual determinations, the examiner must also provide “some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” (*In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir 2006) (cited with approval in *KSR Int’l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007)).

Absent such a *prima facie* case, the applicants are under no obligation to produce evidence of nonobviousness. MPEP § 2142, p. 2100-125 (8th ed. rev. 5, August 2006). To establish a *prima facie* case of obviousness, three basic criteria must be met: *Id.* First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *Id.* Second, there must be a reasonable expectation of success. *Id.* Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *Id.* The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior

art, and not based on applicants' disclosure. *Id.*

The independent claims require collecting application data. This is not taught by Macken.

The Examiner alleges this is taught at paragraph 0037, but is incorrect:

[0037] The customer's needs and processes are then be investigated in more detail. For example, a process migration "toolkit" (i.e., a set of tools adapted to facilitate process migration) may include a template associated with an initial questionnaire to be completed by the customer (e.g., a MICROSOFT® WORD template). Such a questionnaire might be used, for example, to understand a process and to estimate an amount of time that may be required at the first location to further investigate the process and/or to perform a migration. According to one embodiment, the questionnaire is automatically generated and/or transmitted to one or more customer employees (e.g., one section of the questionnaire may be transmitted to a human resources manager while another section is transmitted to a legal department). By way of example, the initial questionnaire could include some or all of the following sections: a contact list, a process description (e.g., including operations, measurements, control aspects and evolution), information technology aspects, human resources aspects, financial aspects, quality information, legal issues and customer expectations.

The "questionnaire" can include sections such as a process description (e.g., including operations, measurements, control aspects and evolution), information technology aspects, human resources aspects, financial aspects, quality information, legal issues and customer expectations, but is not taught to include application data. This limitation is not taught or suggested by the reference.

The independent claims also require storing the application data in a data processing system as a plurality of entries in an application inventory. This is not taught or suggested by the reference,

and the Examiner fails to even attempt to show this limitation in the art. The Examiner fails to make a *prima facie* rejection.

The independent claims require assigning ratings according to a plurality of assessment factors. Macken does mention a “scorecard” in which factors are rated.

The independent claims require averaging the ratings to determine an average rating. This is not taught by Macken. The Examiner alleges that this is taught at paragraph 0039, but is mistaken:

[0039] FIG. 4 is a process migration scorecard display 400 according to some embodiments of the present invention. As can be seen, the display 400 includes a feasibility scorecard and a risk assessment scorecard. Each scorecard includes a number of factors that are rated from "0" (difficult migration) to "5" (easy migration). For example, the complexity of the process is rated "2" indicating that some knowledge and/or ability will be required to perform the process. An overall score is then computed based on these ratings, and the overall score is used to determine whether the process should be migrated. According to one embodiment, certain ratings result in pre-determined actions. For example, a rating below "3" may trigger generation of a risk mitigation action plan.

It is clear that while an “overall score” is indicated, there is no teaching at all in Macken of determining an average rating or that the “overall score” is an average of anything.

In the response, the Examiner mischaracterizes her own previous rejection. In the previous rejection, the Examiner has taken “official notice” that it is “old and well known to average scores as an evaluation tool.” This is certainly true. However, the Examiner now states that “it has been taken as prior art that: it would have been obvious to one of ordinary skill in the art to substitute averaging of a score for a sum of scores, as set forth in the rejections to the claims.” This is not the “notice”

taken by the previous action, and is not a *fact* of which “official notice” can be taken – this is a legal conclusion. This is improper for several reasons.

First, Official Notice is only proper for *facts*. (MPEP § 2144.03). Indeed, Official Notice is only permissible for those few facts that are of a “notorious character” and that are “capable of instant and unquestionable demonstration”. (MPEP § 2144.03(A)). It is improper to use Official Notice for conclusions of law.

Secondly, the Office Action relies on Official Notice as the “principal evidence” upon which the rejection of claim 1 is based. Official Notice cannot be used in this manner. As Section 2144.03(A) of the MPEP expressly warns, it is never appropriate to rely solely on Official Notice as the principal evidence upon which a rejection was based. Instead, Official Notice is only appropriate for facts and that serve to “fill in the gaps” in a rejection. (MPEP § 2144.03(A)). This is why official notice is to be judicially applied. (MPEP § 2144.03). It is unreasonable to conclude that the Office has used Official Notice to “fill in” a gap in this rejection.

Thirdly, the Office attempts to take Official Notice of matter that is not “capable of instant and unquestionable demonstration”, as expressly required by section 2144.03(A) of the MPEP. Indeed, even assuming *arguendo* that the principle that one of ordinary skill in the art could substitute averaging of a score for a sum of scores is a fact, this fact would be neither of notorious character nor instantly and unquestionably demonstrable. Moreover, courts have long rejected the notion that official notice can be taken on the state of the art. (See Memorandum to Patent Examining Corps from the Deputy Commissioner for Patent Examining Policy regarding Procedures

for Relying on Facts Which are Not of Record as Common Sense or for Taking Official Notice, n.6, citing *In re Eynde*, 480 F.2d 1364, 1370, 178 USPQ 470, 474 (CCPA 1973)). Thus, the Office's attempt to officially notice the level of ordinary skill in the art is improper as a matter of law.

In sum, the Office's attempts at Official Notice are improper and traversed.

Moreover, while averaging in general is known, the specific *averaging of assessment factor ratings* is not shown as known in the art, and this is the limitation that the Examiner must show for a proper rejection.

The independent claims also require determining employee migration percentages according to the average rating. This is not taught by Macken, although the Examiner incorrectly alleges it is taught at paragraph 0041:

[0041] Information associated with Full Time Employee (FTE) values (e.g., fifty employees from January through September and sixty employees from October through December) and ramp-up plans for the second location may also be determined via a process migration toolkit template. Prior customer staffing plans (i.e., historical information) can also be used to determine appropriate FTE values. According to one embodiment, information in a FTE plan is automatically used to generate requisitions, such as human resources, technology and/or telecommunication requisitions. For example, a human resources requisition form may be generated and used to initiate hiring of new employees needed for the process. The human resources requisition may also indicate the appropriate skills that are required for those employees (e.g., UNIX.RTM. and database administrator skills).

It is clear that this "information" is not taught to include migration percentages, and is not taught to correspond to any average rating.

The Examiner's response appears to indicate that the Examiner believes the only distinction is "in the substitution of the averaging of score for the sum of scores." This is incorrect. Macken also does not have any employee migration percentages at all. Macken mentions that there can be an "FTE value" as a baseline parameter, but no employee migration percentages. Macken's "FTE value" is not taught or suggested to be based at all on Macken's "scores", whether summed or averaged, as required by the claims.

Applicants must therefore respectfully note that the Examiner's analysis is simply incorrect. No art of record teaches or suggests the advisability, predictability, or possibility of determining employee migration percentages according to the average rating, as claimed.

The Examiner again improperly attempts to use "official notice" to draw a legal conclusion, with regard to claims 1, 5, and 11, stating "Examiner takes official notice that it would have been obvious to one of ordinary skill in the art to calculate a percentage of employees based on the numbers determined in Macken." This is not supported by the art, and is improper for "official notice", as discussed above. This is certainly not a "fact" capable of instant and unquestionable demonstration, and the "official notice" is traversed.

It is not appropriate for an Examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. For example, assertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art. *In re Ahlert*, 424 F.2d at 1091, 165 USPQ

at 420-21. It is never appropriate to rely solely on "common knowledge" in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based. *In re Zurko*, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). As the court held in *Zurko*, an assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support. *Id.* at 1385, 59 USPQ2d at 1697.

There must be some form of evidence in the record to support an assertion of common knowledge. See *Lee*, 277 F.3d at 1344-45, 61 USPQ2d at 1434-35 (Fed. Cir. 2002); *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697. The applicants should be presented with the explicit basis on which the Examiner regards the matter as subject to official notice and be allowed to challenge the assertion in the next reply after the Office action in which the common knowledge statement was made.

If applicants traverse the Examiner's assertion of official notice, the Examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. See 37 CFR 1.104(c)(2). See also *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697. If the Examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2). The Examiner is therefore requested – and required – to provide documentary evidence or an affidavit in support of every fact for which “official notice” is taken.

As Macken fails to teach multiple limitations of the independent claims, all rejections are traversed.

The Examiner has also failed to show any weightings applied to the ratings, as in claims 3, 8, and 13, and apparently confuses weightings with the ratings themselves.

The Examiner has also failed to show any teaching of multiplying the employee migration percentages by the number of full-time equivalent employees, as in claims 4, 9, and 14. This limitation is clearly not taught by paragraph 0041 referenced by the Examiner.

The Examiner also concedes that the limitations required by claims 5, 10, and 15, are not taught by the art, and is incorrect in stating that the manner in which a step is performed, and the factors involved in making the specific determination, are “not functionally involved in the steps recited.” As the Examiner completely fails to show these limitations taught by the art, there is no *prima facie* rejection of these claims.

Accordingly, the Applicants respectfully request the Examiner to withdraw the § 103 rejection with respect to these claims.

CONCLUSION

As a result of the foregoing, the Applicants assert that the remaining claims in the Application are in condition for allowance, and respectfully requests that this Application be passed to issue.


If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicants respectfully invite the Examiner to contact the undersigned at the telephone number indicated below or at *manderson@munckcarter.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 05-0765.

Respectfully submitted,

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